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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/686,007	10/10/2000	Donald J. Palmer	10006545-1	4378

7590 02/17/2005

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Intellectual Property Administration
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EXAMINER

THOMPSON, MARC D

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/686,007

Applicant(s)

PALMER ET AL.

Examiner

Marc D. Thompson

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection on 8/12/2004. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on 6/21/2004 has been entered.
3. Claims 1-2, 4-10, and 12-20 remain pending.

Priority

4. No claim for priority has been made in this application.
 5. The effective filing date for the subject matter defined in the pending claims in this application is 10/10/2000.
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Drawings

6. The Examiner contends that the drawings submitted on 10/10/2000 are acceptable for examination proceedings.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2144

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

8. Claims 1-2, 4-10, and 12-20 are rejected under 35 U.S.C. §102(b) as being clearly anticipated by Farrell et al. (U.S. Patent Number 5,383,129), hereinafter referred to as Farrell.

9. Farrell disclosed statistical tabulation of customer print jobs as notoriously well known in the prior art. See, inter alia, Column 1, Lines 24-26. Farrell taught the provision of r billing, consumables management, and information gathering directly related to printing jobs effected over a network. See, inter alia, Column 3, Lines 38-52. Farrell was primarily concerned with print job cost, consumable requirement, and consumable constituent cost. See, inter alia, Column 3, Lines 8-25. The combination of the prior art specifically cited by Farrell and the advancement of the Farrell teachings provided the combination of printing job costs, printing job consumable monitoring/managing, and statistical gathering of print job information together in a single workable prior art system.

10. Claims 1-2, 4-10, and 12-20 are rejected in view of the breadth of the presented claims in view of the teachings of Farrell.

Art Unit: 2144

11. Claims 1-2, 4-10, and 12-20 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Coons et al. (U.S. Patent Number 6,832,250), hereinafter referred to as Coons.

12. Coons disclosed printing services management in a networking environment. See, inter alia, Abstract, and Column 3, Lines 60-65. Various types of network connections and communication techniques were envisioned in Column 8, Lines 4-18. Data gathered which related to the printing services including cost data for the printing, as well as printing consumable usage and statistical report generation was expressly taught, inter alia, in Column 9, Lines 9-28, and Figure 4.

13. Claims 1-2, 4-10, and 12-20 are rejected in view of the breadth of the presented claims in view of the teachings of Coons.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR §1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(f) or (g) prior art under 35 U.S.C. §103(a).

Art Unit: 2144

16. Claims 1-2, 4-10, and 12-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over Zingher (U.S. Patent Number 5,897,260), hereinafter referred to as Zingher, in view of Davidson, Jr. et al. (U.S. Patent Number 6,025,925), hereinafter referred to as Davidson.

17. Zingher disclosed the allocation of print jobs to various print service providers. See, inter alia, Abstract. Zingher disclosed network communication and print job transfer. See, inter alia, Column 3, Lines 26-40. The system actively stored profiles (databases) of printing facilities, customer print job request requirements/preferences, and provided storage of customer jobs for distribution to a chosen facilities. See, inter alia, Column 3, Lines 52 through Column 4, Line 6, and Column 5, Lines 48-53. The stored printing and preference information provided by customers included print job delivery deadlines, number of copies, job cost involving materials and distribution. See, inter alia, Column 4, Lines 7-28, and Column 6, Lines 19-37. This information was used to select suitable/desired printing facilities for job distribution, also serving to minimize the amount of information required to be distributed, and provide feedback opportunities for the customer/client to examine the details of the printing jobs. See, inter alia, Column 6, Lines 8-18, Column 7, Lines 19-37, and Column 7, Lines 38-55.

18. While Zingher disclosed the invention substantially as claimed, Zingher did not expressly disclose generation of statistical data for printing services. While Zingher specifically disclosed the use of cost, consumables, expected completion time, and collection, storage, and database maintenance for monitored data (inter alia, Column 6, Lines 8-37, and Column 7, Lines 2-55), Zingher remains silent as to how this information is used, specifically in generation of reports or records of statistical information regarding

Art Unit: 2144

the printing services. Zingher did specifically recite the provision for connection between client requestors and printing management terminals directly. See, inter alia, Column 7, Lines 56-60. This would have motivated one of ordinary skill in the art to explore the related arts to identify teachings which dealt with printer manager and printing equipment interfacing, since these functional elements were specifically disclosed, inherent for proper functioning of the printer delivery system, providing observable status indications directly from the equipment performing the function(s). See, inter alia, Column 7, Lines 56-60.

19. In the same art of printer job management, Davidson disclosed statistical printer and job information being maintained temporarily at the printer itself, then transferred to an arbitrary host terminal(s), including a management host for printer and print job data collection. See, inter alia, Abstract, and Column 2, Lines 28-60. Minimally, the Davidson teachings provided generation of statistical information relating to print services as broadly claimed. See, inter alia, Column 14, Line 40 through Column 15, Line 48.

20. Since Davidson provided an interfacing between printer/printing equipment and printer service management terminal(s) was expressly provided in, inter alia, Column 3, Lines 34-65, in addition to handling basic print job maintenance and accounting in, inter alia, Column 4, Lines 7-60, directly suggested by Zingher in, inter alia, Column 3, Line 52 through Column 4, Line 28, motivation exists for one of ordinary skill in the art at the time of invention for modification of the base Zingher system with the advantages provided by the teachings of Davidson. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the Zingher system with the Davidson

Art Unit: 2144

teachings in order to understand printer-to-printer host interfacing and communication (including the specifics of the information exchanged), and better manage print job accounting for particular printers/jobs.

21. Since the combination of Zingher and Davidson disclosed all the limitations as broadly set forth in the claimed invention, claims 1-2, 4-10, and 12-20 are rejected.

Response to Arguments

22. The arguments presented by Applicant with the claim amendments, received on 6/21/2004, are not considered persuasive.

23. Applicant argues the prior art of record does not “teach or suggest collecting and analyzing print services data of print services of a print provider and generation and reporting statistics of the print services...including cost data, a consumable requirement of the print services.” See, Response, received 6/21/2004, Pages 8-9. It is submitted that this broad characterization is fully met by the currently applied art, as well as being notoriously well known at the time of invention. It was typical and conventional to store statistical information, including cost of print jobs. The provision for consumables allocation/assurance was likewise known in network printing job systems. Lastly, these features both fall under general printing system management naturally fitting together in a single network monitoring/management system for basic network services, i.e., printing. Thus, the combination of these specifically known elements is not considered novel.

Art Unit: 2144

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

25. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The Examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Art Unit 2144